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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/761,051 | 01/20/2004 | Christof Schafer | 71268 | 1173 |
| 23872 | 7590 | 08/04/2005 | EXAMINER | |
| MCGLEW & TUTTLE, PC P.O. BOX 9227 SCARBOROUGH STATION SCARBOROUGH, NY 10510-9227 | | | WILLIAMS, THOMAS J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3683 | |

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------|--------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/761,051 | SCHAFFER, CHRISTOF | |
| | Examiner | Art Unit | |
| | Thomas J. Williams | 3683 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Acknowledgment is made in the receipt of the amendment filed June 1, 2005.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 8-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification fails to disclose or illustrate an inner part 5 completely embedded in the rubber buffer 1. The inner part is disclosed as being simply embedded, and is illustrated as merely partially embedded. An item that is completely embedded must be surrounded on all sides.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 22-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Regarding claim 22, it is unclear to the examiner if it is the intention of the applicant to recite the limitation "said first portion" in line 7, since it is unclear how the first portion will hold itself in pretension, as recited in line 8.

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Claims 23-27 are rejected due to their dependence upon claim 22.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 8-21 and 23-27 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,877,262 to Tanahashi et al.

Re-claims 8 and 15, Tanahashi et al. disclose a motor vehicle bearing, comprising: a piston cylinder unit (see abstract); a metallic pot shaped housing 32, the housing is provided with an inner wall; a rubber buffer 20, the buffer has a first portion 42 and a second portion (interpreted as the central portion of the buffer); a inner part 12 is connected to the piston and cylinder unit and is embedded in the buffer; a reinforcing part 24 is embedded in the buffer, the first portion of the buffer is supported at the inner wall via the reinforcing part.

Re-claims 9, 13, 16 and 19, the second part is a damping portion, the first portion 42 is a tensioning portion, see column 4 lines 67-68 to column 5 lines 1-2. Portion 42 is compressed in the same manner as the instant invention, see page 4 lines 1-3.

Re-claims 10 and 17, the reinforcing part is annularly shaped.

Re-claim 11, the inner part is arranged in an axially moveable manner.

Re-claims 12 and 18, the reinforcing part is provided with openings that will vary in the internal diameter.

Re-claim 14, see figures.

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Re-claim 20, see figures 1 and 2.

Re-claim 21, see column 1 lines 56-63.

Re-claim 23, Tanahashi et al. disclose a bearing arrangement, comprising: a body part 30; a housing 32; an elastic buffer 20 having a first portion and a second portion; a reinforcing part 24; the body part, the housing, the first portion (or second portion) and the reinforcing part are shaped and arranged to hold the first portion in pretension when the housing is connected to the body part; a carrier piece 12 is embedded in the buffer; the housing, the second part and the carrier are arranged to damp movement.

Re-claim 24, the piston cylinder unit is connected to the carrier plate; the body part is part of the vehicle body part.

Re-claim 25, the carrier piece and the reinforcing part are spaced from each other.

Re-claim 26, the first portion is tightly fixed to the housing; the second portion is more moveable with respect to the housing than the first portion.

Re-claim 27, the second portion is more of a damping portion than the first portion.

Response to Arguments

9. Applicant's arguments with respect to claims 8-27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Thomas Williams whose telephone number is 571-272-7128. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, can be reached at 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-6584.

TJW

August 1, 2005

THOMAS WILLIAMS
PATENT EXAMINER

Thomas Williams
AU 3683
8-1-05